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EXAMINER

YEAGLEY, DANIEL S

ART UNIT PAPER NUMBER

3618

DATE MAILED: 11/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,459

Applicant(s)

SHOEN, MARK VINCENT

Examiner

Daniel Yeagley

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-7, 9-13, 15-16, 19, 20, 23, 24, 27 and 28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The RCE filed 10/18/01 and the Amendment filed 9/10/01 has been entered.

Election/Restrictions

2. Applicant's affirmation of the election of group I, claims 1 - 24 in Paper No. 4 was acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election was treated as an election without traverse (MPEP § 818.03(a)). Claims 25 and 26 were withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6, 7, 12, 13, 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, 7, 12 and 13, recites the limitation "said first and second angles" which lack antecedent basis. Note; no earlier recitation was made regarding the terms "first" and "second" such that it is unclear which angle applicant considers as the first and/or second angle, and the claim language is indefinite because it is not clear

if a combination of the two angles add up to an angle between 1 and 89 degrees or if each angle has an angle between 1 and 89 degrees which is noted on page 7 of applicants disclosure such that an angle of the clearance increasing portion alone has an angle of between 1 and 89 degrees preferably 40-50 degrees but no specific range of angles were recited regarding the angle of the inner wall.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 - 3, 5, 9 – 11, 15, 16, 19, 20, 23, 24, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Poveromo '664.

Poveromo figure 1 shows a plurality of fenders 20,22 on a trailer or tow dolly, with a light housing 50 attached to a top of the fender which is offset from a longitudinal midline of the fender having a base portion that conforms to the shape of the fender with a raised portion (figure 3) and figure 1 shows the raised portion adapted to receive a light fixture, the fender shown in figure 3 comprises a top portion with a flat middle section and curved end sections at the lateral edges of the opposed inner and outer edges with an outer wall extending downward from the outer edge of the top portion and a clearance increasing portion depending downward at a non-zero acute angle from the inner edge of the top portion to an inner wall which depends downward at a non-zero

acute angle which is perpendicular to the top portion at approximately 90 degrees, figure 5 shows the fender with a plurality of planer sections which is curved in the longitudinal direction and figure 8 appears to show all the bottom edges at the longitudinal ends of the top portion, inner and outer walls and clearance increasing portion that all lie in a common plane.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 - 3, 5 - 7, 9 - 13, 15 - 16, 19, 20, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardwick in view of Nyman '556.

Hardwick showed a plurality of longitudinally curved shaped fenders 15,16 on a trailer or tow dolly (figure 3) wherein the fender comprises a top portion which has a plurality of planer sections (figure 1), figure 2 shows the top portion having a substantial flat middle section that curve at the end sections at opposed inner and outer edges of the top portion, wherein an outer wall extends downward from the outer edge of the top portion of the fender as shown in figure 1 and has at an opposed inner edge as shown in figure 2 a clearance increasing portion that depends downward at an acute angle between a range of 1 to 89 degrees to an inner wall of 11 which depends downward wherein the angles formed by the top portion, the clearance portion and the inner wall

add up to approximately 90 degrees and their bottom edges lie in a common plane as best understood and seen in figure 1 from the left to the right of the fender but lacked the light housing attached to the top portion and mounted offset a midline of the fender.

Nyman '556 shows a plurality of fenders 10, 11 on a trailer or tow dolly having a light housing 13 mounted to the fender 11 offset from a midline of the fender (figure 2 upper wheel shows the light fixture approximately center with the wheel and figure 3 shows the wheel off-centered with respect to the fender), the external surface of the fender (figure 1) has a shape wherein the light housing comprises a base portion that conforms to at least a portion of the shape of the fender (figures 1 and 2), the light housing having a raised portion adapted to receive a light fixture.

It would have been obvious to have modified the fender of Hardwick and added a light housing such as shown in Nyman to provide the trailer dolly with tail lights for added safety and in order to utilized the trailer on public roads to comply with regulations of mounting brake lights to the rear of a trailer as is well known in the art.

9. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardwick '808 as modified by Nyman '556 offset light housing in further view of Robinette et al '162.

Hardwick as modified by Nyman lacked the fender having the entire bottom edge of the top portion, the clearance increasing portion, the inner wall and the outer wall all lying in a common plane. Robinette et al shows a fender which has all bottom edges of

the fender lying in the same common plane as viewed in figure 3 which inherently shows a light housing on the fender but was silent as to such a light housing.

It would have been obvious to one of ordinary skill in the art to have extended all edges of the fender to a common plane as shown in Robinette et al to cover more of the wheel for better protection and aesthetic appearance and for ease of manufacturing and applicant has not disclosed any criticality as to why all or any of the edges need to be in a common plane for the fender to work as well.

Response to Arguments

10. Applicant's arguments filed 9/10/01 and entered 10/18/01 have been fully considered but they are not persuasive. Regarding the 112 rejections; no indication was made in the independent claim 1 as to which non-zero acute angle applicant considers as the first or second angle and it does not clearly identify if each acute angle or a combination of the two acute angles together add-up to the limited range as claimed or why if any, this range limitation of the acute angle or angles combined is critical or if any range would not work equally as well. Hardwick shows a fender generally curved in a longitudinal direction having a top portion with a tapered clearance increasing portion and shown converging to the inner side of the rectangular beam (column 2, line 57-60 and column 3, line 1-4) which is viewed as being fastened to the inner side of beam 11 forming a 90 degree angle between the vertical wall and the top portion, wherein figure 1 shows the bottom edge at the left and right side of the fender which lies in a common plane and wherein Robinette et al figure 3 clearly shows a

fender with all the bottom edges in the same common plane, Nyman shows the prior art of a light housing offset from a midline of a fender and the claims as broadly read are readable on Poveromo '664 as recited above.

Allowable Subject Matter


11. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: none of the prior art found shows the clearance increasing portion extending at an angle from the longitudinal curved top portion to an inner wall wherein the exterior surface of the clearance increasing portion is concaved between the top portion and the inner wall.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Yeagley whose telephone number is 703-305-0838. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

D.Y.
November 21, 2001


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11/26/01